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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Masahide Hio

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/893,931	<b>Applicant(s)</b> HIO ET AL.	
	<b>Examiner</b> ROSS N. GUSHI	<b>Art Unit</b> 2833	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input checked="" type="checkbox"/> Other: <u>attachment</u> . |

## **DETAILED ACTION**

### ***Specification***

The amendment filed 12/22/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "so that the locks 17 lie in a single plane normal to the side walls 12 and normal to the base 11, as shown in figure 11." Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, regarding claim 9, the limitation of that "each of said locks being completely planar to define a single plane aligned normal to the respective side walls and the base wall" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotea in view of Chesnais et al. ("Chesnais"), Abe, and Volstorf. Regarding claim 9, Hotea discloses an insulation-displacement terminal fitting, comprising: a base wall 12, first and second opposed parallel side walls (15, 16) projecting perpendicularly from opposite sides of the base wall and defining a wire-receiving space between the side walls, first and second opposed V-shaped insulation-displacement portions projecting respectively from the first and second side walls into the wire-receiving space (at 6, see figure 2 and col. 1, line 60), first and second locks (not labeled, see figure 2, showing the locks rearward of the v-shaped IDC portions) projecting respectively from the first and second side walls into the wire-receiving space in positions spaced from the insulation-displacement portions, said first and second locks having opposite planar surfaces and being formed respectively with first and second edges extending between the opposite planar surfaces of the respective locks, the first and second edges defining portions distal ends of the respective first and second locks furthest from the respective first and second side walls, projecting ends of the insulation-displacement portions

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being configured for cutting a resin coating on a wire inserted into the wire receiving space so that a core of the wire contacts the projecting ends of the insulation-displacement portions, and the edges of the locks being disposed to bite into the resin coating and engage cut-open surfaces of the resin coating, for resisting a pull out force on the wire in directions along the longitudinal direction of the wire and normal to the planar surfaces of the locks.

Hotea shows the locks as being inclined slightly toward the IDC portions (see figure 2). Abe discloses a connector where the locks 11 are shown unambiguously perpendicular to the side wall with each of the locks 11 being completely planar to define a single plane aligned normal to the side walls (see figure 1a) so that the planar surfaces of each of said locks 11 are aligned normal to a longitudinal direction of the wire. Likewise Chesnais a connector where the locks (7, 8) are shown unambiguously perpendicular to the side wall with each of the locks (7, 8) being completely planar to define a single plane aligned normal to the side walls (see figure 4) so that the planar surfaces of each of said locks are aligned normal to a longitudinal direction of the wire.

At the time of the invention, it would have been obvious to have the Hotea locks be configured perpendicular to the side walls as taught in Chesnais and Abe. The choice between having the locks inclined slightly (as in Hotea) or perpendicular to the sidewalls (as in Abe and Chesnais) would have been a matter of engineering design choice. The substituted components and their functions were known in the art. One with ordinary skill in the art could have substituted one known element for another and

the results of the substitution would have been predictable. *KSR International Co. v. Teleflex Inc.*, 82 USPQ.2d 1385 (2007).

Hotea does not disclose each of the V-shaped insulation-displacement portions having front and rear planar plates that meet unitarily at a projecting end of the respective V-shaped insulation displacement portion. Volstorf discloses V-shaped insulation-displacement portions (see e.g. dimples 80, 82 or prior art dimples 98, 100) including that each of the V-shaped insulation-displacement portions having front and rear planar plates that meet unitarily at a projecting end of the respective V-shaped insulation displacement portion so that a V-shaped cutting edge faces up on each V-shaped insulation displacement portion. At the time of the invention, it would have been obvious to replace the Hotea V-shaped insulation-displacement portions with other known V-shaped insulation-displacement portions such as those taught in Volstorf. The substituted components and their functions were known in the art. One with ordinary skill in the art could have substituted one known element for another and the results of the substitution would have been predictable. *KSR International Co. v. Teleflex Inc.*, 82 USPQ.2d 1385 (2007). The suggestion or motivation for doing so would have been to create stiffer V-shaped insulation-displacement portions for better cutting of the insulation as taught in Volstorf and as was known in the art.

Per claim 12, locks project by a sufficient distance for contacting the core (as taught in Abe and Chesnais).

Per claim 13 the locks and the insulation-displacement portions project substantially equal distances from the respective side walls (see e.g. figure 2 of Hotea).

Per claim 14, Hotea discloses a front end defining an engaging portion for engaging a mating terminal, the insulation displacement-terminal portions being rearward of the engaging portion, the locks being rearward of the insulation-displacement portions (see figure 2).

Per claim 15, Hotea discloses a crimping portion on a side of the locks opposite the V-shape insulation-displacement portions, the crimping portion being configured for crimped or folded connection with a wire (see attachment).

### ***Response to Arguments***

Applicant's arguments have been considered. Regarding the 35 U.S.C. 112, first paragraph, rejection, applicant cites the specification where the specification specifically states that the locks extend "at a substantially right angle from the respective sidewall." Nowhere in the specification does it state that the locks must be in a single plane normal to the sidewalls. The amendment to the specification adding this limitation is new matter and must be canceled. The limitation that the locks be normal to the sidewall was only added in response to the rejection over the prior art.

Applicant's arguments regarding the 35 U.S.C. 103(a) rejections are moot in view of the new grounds of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (571) 272-2005. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Renee Luebke, can be reached at 571-272-2009. The phone number for the Group's facsimile is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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/Ross N. Gushi/

Primary Examiner, Art Unit 2833